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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 10/666,287 | 09/19/2003 | James M. Mathewson II | RSW920030196US1 | 9038 |
| 7590 | 01/18/2005 | | EXAMINER | |
| A. Bruce Clay IBM Corporation T81/503 PO Box 12195 Research Triangle Park, NC 27709 | | | KIM, AHSHIK | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2876 | |

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/666,287 | Applicant(s) MATHEWSON ET AL. | |
| | Examiner Ahshik Kim | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/19/03 (Initial filing of application).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

5 In pages 1 and 2: several occurrences of "U.S. Patent _____ (serial number 10/_____) are not completed/filled-in. These fields need to be updated as filed applications are assigned serial numbers and US Patent numbers (when they are issued).

Appropriate correction is required.

Claim Objections

- 10 2. Claim 3 is objected to because of the following informalities:

Re claim 3, line 3: substitute "each or one or more" with --each of one or more--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

- 15 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

20 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 25 4. Claims 1, 3, 5-8, 10, 12-15, 17, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Otto (US 6,554,187 B2, hereinafter "Otto").

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Re claims 1, 3, 5, 8, 12, 15, 17, and 19, Otto discloses a system and the method for detecting whether the item is stolen utilizing RFID label information (see abstract; col. 1, lines 31+). When an item is purchased, transaction information is recorded into the RFID tag (col. 1, lines 11-15; col. 2, lines 32-34). When the transactional information such as date and time of purchase, location of purchase, and seller, the item may be considered to be stolen (col. 2, lines 16+).

Re claims 6, 7, 13, 14, 20, and 21, when the items are taken into a store by the customer, the RFID interrogator interrogates the item by store ID or at the transaction level (col. 2, lines 37-63+).

Re claim 10, when a plurality of items are purchased at one time (or at the same time), the transaction detail information such as purchase time, place, and sales clerk would be identical (col. 2, lines 32+).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 4, 9, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable
5 over Otto (US 6,554,187 B2) in view of Clare (US 5,745,036, hereinafter "Clare").

The teachings of Otto have been discussed above. Otto further discloses uses of inventory data file 22 and other files. Otto, however, fails to specifically teach that the transaction data is stored in the database.

Clare teaches electronic article surveillance system (see abstract) utilizing RFID security
10 tag applied to the articles (col. 1, lines 11+; col. 2, lines 5+). When an article is purchased, a transaction record (see figures 4 and 5(a)) including transaction identifier and detailed transaction information is generated and stored in the database (col. 6, lines 17+). When the item goes through exit, the item's authenticity is checked at the transactional level (col. 6, lines 29+; col. 8, lines 18+).

15 In view of Clare's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to compare the product's status at the transactional level in order to improve the reliability of authentication process. Otto, in a simplified manner, shows only the inventory file and promotional file. However, recording transactional level data at the retail store is well known in the art. Although Otto was silent about details of the transaction, the
20 checkout device in the retail store often records transactions for accounting and financial purposes. Accordingly, comparing the authenticity of purchase at the transaction level compared

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to store ID verification would have been more reliable measure of comparison, well within one ordinary skill in the art.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Wischerop et al. (US 5,955,951); Elledge (US 6,609,656); Anderson et al. (US 6,333,692); Bodin (US 6,681,989); Lowe et al. (US 5,874,896) disclose various article surveillance system comprising RFID tag/label. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
January 13, 2005